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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shah

Serial No.: 09/248,524 Group Art Unit: 1617

Filed: February 9, 1999 Examiner: Wells, Lauren Q.

For: Long-Wearing Cosmetic Compositions

REMARKS

I. The terms "long-wearing" and "derived" are definite:

The Examiner asserts that the term "long-wearing" is a relative term and is indefinite as it used in the present claims. The Examiner poses a series of questions which includes, "Does long wearing mean that it lasts for 48 hours, for 2 hours, for 2 minutes?" Further, the Examiner notes that Applicant has provided no evidence as to how this term is routinely defined in the art. However, Applicants previously submitted 3 references containing cosmetic claims using the term "long-wearing" to demonstrate that the authors were not required to provide a lower limit in order to define the term.[1] The present issue is directed toward the upper limit which it has been previously pointed out by Applicants[2] is provided in the specification which one of ordinary skill in the art can refer, and therefore, understand the clear and concise definition of "long wearing" as the term is used in the present application similar to the 3 references previously submitted. The answers to the Examiner's questions are found in the present specification, and Applicants submit that one of ordinary skill in the art would not ask such questions based on the claims that are read in light of the specification.

The present specification at page 5, lines 25 to 30 sets forth that the compositions of the present invention can be retained on the skin for up to a full day, i.e., 24 hours, without smudging or running. Construing the meaning of the term "long wearing" in the present claims based on the disclosure in the specification, one of ordinary skill in the art would know and understand the scope of the term. Specifically, the specification states.

> . . . *The compositions of the present invention* can also be in the form of eye or skin products whereby the product is used to create body art on the face around or in close proximity to the eye. . . . Although it will be temporarily drawn on the skin, *the art form can be retained up to a full day without smudging or running* and can be removed with soap and water or any solvent based makeup remover.

[1] It is noted in the present action that the lower limit is irrelevant after this was an issue for several office actions.

Thus, one of ordinary skill in the art upon reading the present specification would reasonably know and understand that the term "long wearing" clearly and concisely means up to 24 hours (the number of hours in a day). The request by the Examiner for evidence that this term is routinely defined in the art in this manner is not required by section 112 because the specification provides the context for the construction of the claims. *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 1302, 53 USPQ2d 1065, 1070 (Fed. Cir. 1999), *Wang Laboratories, Inc. v. America Online, Inc.*, 197 F.3d 1377, 53 USPQ2d 1161 (Fed. Cir. 1999), and *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 59 USPQ2d 1865 (Fed. Cir. 2001). The court in *Toro* found that the specification described an embodiment showing a ring permanently attached to a cover and listed advantages of permanent attachment. *Id.* at 1301. In concluding that a claim reciting "a cover 'including' a restriction ring" should be construed to require attachment, the court noted that "clear statements of scope" in the specification determined the correct claim construction. In the present specification, it is set forth that the compositions last for up to one full day. This is a discrete amount of time and it is difficult to comprehend how this could be any more clear and concise. Thus, one of ordinary skill in the art reading the statement of scope in the present specification as indicated above, would understand the meaning of the term "long wearing" as used in the claims.

Further, Applicants have previously submitted references indicating how the term "long wearing" is used in the art. In U.S. Patent Number 6,444,212, issued as recently as September 3, 2002 while the present application was repeatedly being objected to for the use of the very same term, "long-wearing" was allowed in the '212 claims while the '212 specification ***fails to provide a minimum or maximum value*** defining the term. The Examiner notes that the prosecution of every application is distinct. Nonetheless, the focus in examining the '212 reference is not on the prosecution of the application but rather the choice of words made by the author in the absence of providing a definition for the words that were chosen. Use of the term "long wearing" in the '212 reference by the author demonstrates that one of ordinary skill in the art would know and understand the meaning of the term "long wearing" without providing a maximum value to define the term, and moreover, without providing any definition at all. Thus, this is evidence of how one of ordinary skill in the art routinely uses the term. In addition, Applicants previously submitted two other examples of claims using the term "long-wearing". In each example, there is no range, and more specifically, ***there is no upper or lower limit provided*** for the term "long-wearing". Thus, Applicants request that this rejection be withdrawn.

[2] See Applicants' Response of December 17, 2001, page 2, first paragraph.

Another term found by the Examiner to be indefinite is the word "derived." The Examiner questions whether the claim refers to acrylic acid polymers or polymers derived from acrylic acid. It remains unclear to Applicants how questions can be posed as to what a polymer derived from acrylic acid is as this is a term of the art routinely used in chemistry. Applicants are not required to describe that which is known by one of ordinary skill in the art. Previously, in Applicants' Response of July 9, 2002, submitted evidence demonstrating the use of the term "derived" in the context of general polymers and specific acrylic and methacrylic acid derived polymers, in U.S. Patent Nos. 6,074,996, 6,264,934, and 6,284,233. Applicants demonstrated that one of ordinary skill in the art understands what the term derived means and in the context of the present claims it is understood that an acrylic acid polymer is synonymous with an acrylic acid derived polymer or a polymer derived from acrylic acid based on the description provided in the present specification. Therefore, Applicants amend the claims and request that this rejection be withdrawn.

II. Water-soluble and water-insoluble polymers are not interchangeable:

The Examiner rejects Claims 1 to 15, 17, and 19 to 22 over Valdes et al. (U.S. Patent No. 4,761,277, "the '277 reference") in view of Alwattari et al. (U.S. Patent No. 5,874,072, "the '072 reference"). The present invention relates to compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment. One of the water-soluble pigments described in the present invention is FD&C yellow No. 5. The Examiner asserts that the '277 reference teaches water soluble organic pigment that is FD&C Yellow 5 but that the '277 references lacks a teaching of a polymeric component. For this teaching, the Examiner turns to the '072 reference wherein the Examiner finds that acrylic type polymers are taught. Specifically, at column 1, lines 66 to column 2, line 66, the '072 reference discloses water-insoluble polymeric materials such as acrylate copolymers formulated with added ammonia. In combination, i.e., the '277 and the '072 references, the Examiner believes that one of ordinary skill in the art would add the polymer from the '072 reference to the '277 compositions because there would be an expectation of achieving a cosmetic with superior wear and yet is removable with soap and water.

Applicants respectfully traverse the Examiner's line of reasoning because the polymers from each of the references are not interchangeable when considering that the polymer in the '277 reference is a water soluble polymer combined with polyvinyl alcohol and the polymer taken from the '072 reference to be added to the '277 compositions is water insoluble. Thus, one of ordinary skill in the art would not make the substitution contemplated by the Examiner. At column 2, line 20, of the '072 reference the subject heading for the section that includes th acrylate copolymer is "A. **Water-insolubl** Polymeric

Matcrials." I n contrast to this in the '277 reference, at column 1, line 63 to column 2, line 4, and contrary to the Examiner's assertion that the '277 reference lacks polymeric components, the '277 reference clearly explains that its "**water-soluble** aqueous **polymer** film-forming agent" comprises a combination of polyvinyl pyrrolidone (PVP) and polyvinyl alcohol (PVA)." Thus, not only does the '277 referencc contain a polymeric component, but the '277 reference contains a specific water-soluble polymeric component of PVP and PVA. Therefore, onc of ordinary skill in the art would not make thc combination of the references proposed by the Examiner, and a *prima facie* case of obviousness has not been made.

Finally, the Examiner cites Burdzy (U.S. Patent No. 5,518,728, "the '728 reference") for the premise that eycliners and lipliners are interchangeable cosmetic product types, at column 10, lines 58 to 65. Essentially at the section cited by thc Examiner, the authors recite a number of different forms of cosmetics that the alleged invention can take. There is no indication that any of the forms are intended to be interchangeable as the list includes lipsticks and lip liners, powder products and crème blushes. All that is noted is that the alleged invention can be made in any of the mentioned forms. Further, the '728 reference fails to remedy the defect in the combination of the '277 and the '072 references, namely that therc is no motivation to interchange water soluble polymers with water insoluble polymers. Thus, a *prima facie* casc of obviousness has not been made and the claims of the present invention are patentable in view of the references cited by the Examiner. Accordingly, the claims are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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